

REMARKS

By this amendment, claims 3, 34, 35, 39, and 40 are amended, and claims 36 and 42 have been cancelled without prejudice. These amendments are made to more clearly recite the claimed invention, do not add prohibited new matter and are fully supported by the specification. Support for these amendments may be found throughout the present specification. Reconsideration and withdrawal of the rejections in the outstanding Office Action are respectfully requested in view of the following remarks.

Rejections Under 35 U.S.C. § 102(b)

The Office Action rejects claims 34-43 under 35 U.S.C. § 102(b) as being anticipated by Matsuzaki et al. (U.S. Patent No. 5,357,439, hereinafter “MATSUZAKI”). Applicants respectfully traverse this ground of rejection.

In the outstanding Office Action, the Examiner asserts that the claimed invention is disclosed in Figure 9 of MATSUZAKI. Although Figure 9 shows a “Walk Through Custom Shopping Center,” Applicants submit that this Figure does not disclose “patterned special type” commodities or a “patterned special type commodities menu” because it is mainly directed to “custom” products (which have made-to-order shapes, etc.), rather than “patterned special type” commodities (as recited in the claims and described in the specification).

As recited in the claims, the “form of the patterned special commodity is fixed and a size of the patterned special type commodity may be varied by the customer.” On the other hand, MATSUZAKI discloses products that are completely custom-order with no fixed parameters. Thus, Applicants submit that MATSUZAKI does not teach a system in which the claimed “patterned special type” commodities are stored, let alone a system in which the claimed

“patterned special type” commodities are presented in a “patterned special type commodity menu” (as recited in the claims and described on page 3 of the present specification). Thus, Applicants submit that MATSUZAKI fails to disclose each and every feature of the claimed invention, as required under 35 U.S.C. § 102, and respectfully request withdrawal of the outstanding rejections.

Furthermore, Applicants submit that MATSUZAKI does not disclose a “system that...searches a database for price estimates for the patterned special commodity,” as recited in the claims. The Examiner asserts that Figure 24 (unit 2-61) discloses this feature of the claimed invention. Although MATSUZAKI discloses a “cost and due date estimating unit,” MATSUZAKI describes the “cost and due estimating unit” as follows:

The order information processing unit 2-6 includes a cost and due date estimating unit 2-61 with a pattern learning function and an estimated model parameter storing unit 2-62. For estimating the due date of the current product specification stored in the product specification storing unit 2-1, the order information processing unit 2-6 employs the state data of the current manufacturing equipment stored in the operation information storing unit 203 and transmitted from the producing department, the specifications of the product ordered in the past and stored in the manufacturing estimate storing unit 2-2, the cost and the duration required for the production of the product, and the results of the state data about the manufacturing equipment at each manufacturing time. The estimating result is sent back to the product specification defining system 1.

MATSUZAKI thus fails to teach that the “cost and due estimating unit” operates “by searching for quotations related to similar commodities” in order to retrieve an automatic quote, based on whether the product is a pattern special type product, as recited in the claims and described on page 23 of the present specification. Thus, MATSUZAKI does not disclose or suggest searching for quotations on previously order similar products. For this reason, Applicants submit that MATSUZAKI does not disclose each and every element of the claimed invention, as required for an anticipation rejection under 35 U.S.C. § 102.

In the outstanding Office Action, the Examiner argues that MATSUZAKI discloses a system “wherein the introduction of a cause of a malfunction of a commodity and measures to avoid the malfunction” (previously recited in claim 36). The Examiner argues that MATSUZAKI discloses a virtual street, which only offers allowable user inputs. Thus, it appears that the Examiner has concluded that the virtual street provides a “measure to avoid...[a] malfunction.” However, Applicants submit that this feature of MATSUZAKI does not actually provide the user with potential commodity malfunctions and instructions on how to avoid said malfunctions.

The Examiner argues that the virtual street does not allow users to choose certain streets associated with potential malfunctions, thereby allowing users to avoid said malfunctions. Applicants respectfully disagree with the Examiner’s interpretation of the MATSUZAKI. Without agreeing with or acquiescing to the rejection, Applicants note that claim 36 has been amended to recite “wherein the information terminal presents...possible commodity malfunctions and instructions on how to avoid the possible commodity malfunctions, *when the user selects commodities associated with commodity malfunctions,*” in order to further accentuate the distinctions between the claimed invention and MATSUZAKI. Accordingly, Applicants submit that that MATSUZAKI fails to teach this feature of the claimed invention.

With regard to dependent claims 41 and 43 (and previously recited claim 42), in Applicants’ Office Action response filed on September 24, 2007, Applicants argued that the Examiner did not address the claim elements recited in dependent claims 41 through 43, and there is nothing in MATSUZAKI which teach or suggests these elements. In response, the Examiner asserted that the elements recited in claims 41-43 are directed to “non-functional descriptive material,” and, therefore, the Examiner has “given the limitations appropriate patent

weight” (*i.e.*, the Examiner has not fully considered these features). In response, Applicants submit that the specific types of commodities, as recited in dependent claims 41 and 43, are indeed functional elements of the claimed invention. The types of commodities effect the product parameters, processing of user input, and how user input would be handled; these aspects are functional aspects of the claimed invention. Applicants maintain that MATSUZAKI fails to disclose the features of claims 41 and 43, and the Examiner has failed to show where MATSUZAKI discusses aspect of the claimed invention. Thus, Applicants respectfully request reconsideration of claims 41 and 43, and withdrawal of the rejections.

Lastly, with regard to dependent claim 35, the Examiner asserts that the “in-person” appointment feature of the claimed invention is not “relevant” because claim 35 is an apparatus claim. Applicants respectfully disagree, noting that MATSUZAKI merely discloses a “virtual” street where users may browse goods. In contrast, managing and conducting “in-person” appointments requires different information and processes than that required for merely browsing a virtual store. Furthermore, without acquiescing to or agreeing with the rejection, Applicants note that claim 35 has been amended to recite “wherein the server *further comprises a manager that* manages a customer database and carries out focusing of target customers and management of a visit schedule for in-person appointments between customers and the user.” Thus, Applicants submit that this is a “relevant” feature of the claimed invention, and submit that MATSUZAKI fails to disclose this element of the claimed invention.

For at least these reasons, Applicants submit that MATSUZAKI fails to disclose each and every feature of the claimed invention, and respectfully request withdrawal of the outstanding rejections.

Rejections Under 35 U.S.C. § 103(a)

The Office Action rejects claims 3-28, 69, and 70 under 35 U.S.C. § 103(a) as being unpatentable over MATSUZAKI in view of Peterson (U.S. Patent No. 5,603,419, hereinafter "PETERSON"). For the reasons discussed in detail above, Applicants submit that MATSUZAKI fails to disclose all of the elements of the claimed invention. Applicants submit that PETERSON fails to disclose or suggest the features lacking in MATSUZAKI. For at least these reasons, Applicants submit that the combination of MATSUZAKI and PETERSON do not teach all of the elements of the claimed invention.

As discussed in the previous Office Action response, MATSUZAKI does not disclose the claimed information management system (as recited in claim 3), which is configured to select "a facility that can provide the ordered product, and transmit...to the product facility instructions for providing the product." Accordingly, the Examiner relies upon PETERSON to teach this element. The Examiner asserts that PETERSON describes the practice of outsourcing, and concludes that it would be obvious for one skilled in the art to incorporate this practice with the teachings of MATSUZAKI.

However, Applicants submit that there is nothing in either MATSUZAKI or PETERSON that provides a motivation or suggestion to combine these publications. Moreover, neither MATSUZAKI nor PETERSON teaches an information system, which is configured to select "a facility that can provide the ordered product, and transmit... to the product facility instructions for providing the product," (using independent claim 3 as a non-limiting example). Applicants further maintain that PETERSON merely teaches a metal shipping rack and briefly discusses outsourcing in the background section. Thus, one skilled in the art would not have proper guidance or reasons to combine the cited publications. Even *assuming* *arguendo* that one skilled

in the art would combine the cited publications in the manner suggested by the Examiner, a skilled artisan would not arrive at the claimed invention because the teachings of these publications are still deficient. Thus, Applicants submit that the cited publications (either singularly or in combination) fail to disclose or render obvious all of the elements of the claimed invention, and respectfully request withdrawal of the outstanding rejections. Furthermore, Applicants submit that claims 4-28, 69, and 70, which depend from independent claim 3, are allowable for at least the same reasons applicable to claim 3.

Applicants also note that the Examiner has not specifically addressed the elements of claim 70 in his rejection. Claim 70 recites the support system of claim 3, “wherein the product comprises a metal mold for a sheet metal processing machine.” Applicants submit that neither MATSUZAKI nor PETERSON disclose or render obvious the elements of claim 70 because both MATSUZAKI and PETERSON do not discuss sheet metal processing or molds, let alone the necessary means for managing sales related to molds for a sheet metal processing machine.

Lastly, even in view of recent clarification of standards for combining prior art by the Supreme Court (e.g., *KSR International v. Teleflex*), Applicants submit that there is no logical reason to combine the cited publications. As explained in Section 2142 of the MPEP, “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, ...[127 S. Ct. 1727 (2007)], 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. The Federal Circuit has stated that ‘rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the

legal conclusion of obviousness.’ ” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

The Examiner does not provide proper reasons why the claimed invention would be obvious. Rather, the Examiner merely concludes it would have been obvious to one skilled in the art at the time the invention was made to combine the teachings of MATSUZAKI and PETERSON because combination of these documents would “incorporate the practice of outsourcing in order to maximize resources in manufacturing a multi-part apparatus” (*see* page 4 of the outstanding Office Action). Applicants submit that the Examiner is relying upon impermissible hindsight by relying upon the disclosed advantages of the claimed invention, as provided in the Applicants’ own specification, as a roadmap for combining the cited publications. Moreover, the Examiner’s conclusions are mere speculation on his part. The Examiner has cited no evidence that the proposed combination will result in the asserted advantages.

Furthermore, upon review of the exemplary rationales provided in MPEP § 2143, it appears that the Examiner has not relied upon any of these exemplary rationales. Although this list is not an exhaustive list of rationales used to support a *prima facie* case of obviousness, this list simply accentuates that, in the present case, the Examiner has not provided a “clear articulation of the reason(s) why the claimed invention would have been obvious,” as recommended by section 2141 of the MPEP and the Supreme Court’s decision in *KSR International*. On the contrary, the Examiner merely focuses upon the advantages of the claimed invention in seeking guidance on why one skilled in the art would combine the cited publications, which the Examiner admits do not teach or even suggest all of the elements of the claimed invention. Applicants submit that this is the very definition of impermissible hindsight.

Even assuming *arguendo* that the Examiner's obviousness conclusion is based upon the assertion that it would have been "obvious to try," Applicants submit that this rationale would be inappropriate because such a rationale is only proper where there is "a finite number of identified, predictable solutions, with a reasonable expectation of success." Applicants submit that there are a myriad of ways in which one could "incorporate the practice of outsourcing in order to maximize resources in manufacturing a multi-part apparatus" (*see* page 4 of the outstanding Office Action). Therefore, Applicants submit that the Examiner has not set forth a *prima facie* case of obviousness because the Examiner has not provided a sound rationale for combining the teachings of these publications.

In view of the above remarks and amendments to the claims, Applicants submit that the claims are not obvious over the applied art of record, and respectfully requests withdrawal of the 35 U.S.C. § 103 rejection, along with an indication of the allowability of those claims.

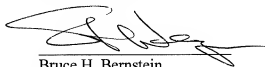
CONCLUSION

In view of the fact that none of the art of record, whether considered alone or in combination, discloses or suggests the present invention as now defined by the pending claims, and in further view of the above amendments and remarks, reconsideration of the Examiner's action and allowance of the present application are respectfully requested and are believed to be appropriate.

The undersigned hereby authorizes the U.S. Patent and Trademark Office to charge any fees necessary to maintain the pendency of the above-identified application, including any basic filing fees, application size fees, search fees, examination fees, extension of time fees, and claim fees, to Deposit Account No. 19-0089.

Should the Examiner have any questions or comments regarding this amendment, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Toshio TAMURA et al.



Bruce H. Bernstein
Reg. No. 29,027

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GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

Steven Wegman
Reg. No. 31,438